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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 96-108-C2	
	Application Number 09/654,933	Filed September 1, 2000	
	First Named Inventor WALKER, Jay S.		
	Art Unit 3624	Examiner COLBERT, Ella	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number **33,384**



Signature

Stephan J. Filipk

Typed or printed name

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

203-461-7252

Telephone number

October 30, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of **1** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application No. **09/654,933** Customer No. **22927**
Filed: **September 1, 2000**
Examiner: **COLBERT, Ella** Confirmation No. **7050**

REMARKS AND ARGUMENTS

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Office Action mailed June 30, 2006 (the “Office Action”). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

A. Introduction

Claims **49-62, 70, and 73-80** are pending in the present application. Claims **49, 61, 62, 70, 73, 74 and 80** are independent claims.

Claims **49, 61, 62, 73, 74 and 80** stand rejected under 35 U.S.C. §112. As best understood, claim 73 stands objected to for allegedly lacking antecedent basis. Lastly, all pending claims stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Wilcox, WO 00/60487 (hereinafter “Wilcox”), in view of “Google cash-back reference” (hereinafter Google), and further in view of Hoffman, U.S. Patent No. 5,297,026 (hereinafter “Hoffman”).

We note that prosecution has already been reopened, and Applicants continue to be frustrated by the failure of the Examiner to advance the prosecution of this application. Many of the Examiner’s current rejections and objections are curious and/or are unsupported. As this case has been pending for over **6 years**, we would welcome any guidance that the panel may have for overcoming the Examiner’s apparent reluctance to advance prosecution.

B. The 35 U.S.C. §112 Rejections

Claims **49, 61, 62, 73, 74 and 80** were rejected for allegedly being indefinite. With regard to claims **49 and 80**, the Examiner states:

“Claim 49, lines 8 and 9 contain a conditional statement. It is unclear what happens “if the customer does not agree to the modification of the parameter. Is the customer made an offer? Claim 80 has a similar problem.”

"Claim 49 also recites a "first value", "second value" and "parameter". One of ordinary skill... would be hard put to identify a "first value", "second value" and "parameter". Such "values" and "parameters" are broad, varied and constantly changing". (Office Action, page 3, paragraph 4).

Claims **49** and **80** both recite to *provide an offer to a customer... wherein the offer comprises an offer to provide payment to the customer if the customer agrees to the modification of the parameter...* We assert that such language is definite and understandable. Furthermore, there is no need to define "what happens if the customer does not agree", which the Examiner is apparently suggesting. There is no basis for such a requirement.

Claim **49** recites a method for *determining first and second values for a parameter of a credit account, calculating a payment, and providing an offer to a customer to provide the payment to the customer, if the customer agrees to a modification of the parameter*. We submit that one skilled in the art would understand how to practice the invention based on this language, and thus the Examiner has no basis for her position that such language is indefinite.

With regard to claims **61** and **73**, the Examiner states:

"Claim 61 recites "an apparatus". This recitation is vague and indefinite. It is not understood if the "apparatus" is a computer or some type of "device". Claim 73 has a similar problem." (Office Action, page 3, paragraph 4).

This rejection does not make any sense. 35 U.S.C. §101 recites that: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter... may obtain a patent..." Use of the term "apparatus" in patent claims is standard practice, and there is no requirement to specify a type of apparatus in the preamble of such a claim. Accordingly, there is no support for such a rejection.

With regard to claims **62** and **74**, the Examiner states:

"Claim 62 recites "a medium encoded with a program for implementing a method, ... steps of:". The recitation "a medium..." is vague and indefinite. The "medium" needs to be a computer-readable medium encoded with computer-readable program for executing computer-readable instructions for implementing a method...." Claim 62 (sic. 74) has a similar problem." (Office Action, pages 3-4, paragraph 4).

Again, such a rejection makes no sense. We assert that the language of these claims is definite and understandable. Furthermore, no support was provided for a "computer-readable medium" requirement, and thus such a rejection cannot stand.

In view of the above remarks, we submit that all of the 35 U.S.C. §112 rejections cannot stand.

C. The Objection of claim 73

The Examiner objected to claim 73 and required correction because, as best understood, the recitations of “the storage device” and “the processor” in line 4 allegedly have no antecedent basis. The Examiner is incorrect; line 2 of claim 73 recites “*a storage device*”, and line 3 recites “*a processor in communication with the storage device*”. Thus, this objection should be withdrawn.

D. The 35 U.S.C. §103(a) Rejections

All of the pending claims were rejected for allegedly being unpatentable over Wilcox, Google, and Hoffman.

Wilcox discloses a system for prequalifying a consumer for credit. The Examiner cited page 8, lines 5-19 of Wilcox for allegedly disclosing *determining a first value for a parameter of a credit account, and for determining a second value for the parameter*, recited by independent claims **49, 61 and 62**. But the cited passage pertains to preselection criteria used to determine creditworthiness, and describes the steps of Fig. 1 that concern prequalifying the consumer for credit, offering the consumer an opportunity to enroll for credit if he qualifies, or just proceeding with the transaction if he does not qualify. There is no teaching or suggestion to perform the process of claims **49, 61 and 62** highlighted above.

Furthermore, the Examiner admits that Wilcox does not disclose *calculating a payment based on a modification of the parameter from the first value to the second value, and providing an offer to the customer associated with the credit account, wherein the offer is to provide the payment to the customer if the customer agrees to the modification* as recited by claims **49, 61 and 62**. But the Examiner cites the following passages of Hoffman as teaching such as process:

“...The offering entity, which is in the business of accepting purchases by customers (or accepting some form of account activity), calculates the sum of total purchases made by the customer during a preselected period, or in some cases, records only a single large purchase. The offering entity then accepts investment funds from the investor/customer up to a prescribed, pre-agreed proportion of the sum of purchases made by the investor/customer during the preselected period. The firm may provide a deposit account for the investor/customer, crediting the investment funds received from the investor in the deposit account, along with interest which accrues at a relatively high rate.

By this system, a firm promoting goods and services is able to offer an attractive, safe and liquid investment opportunity to customers in return for the customer's making purchases. The customer receives a rate of return considerably higher than available in money market accounts, certificates of deposit, or other relatively safe

investments, and in fact the investment provided under this system is more liquid than most investment programs claiming to give a high yield.” (Hoffman, col. 2, lines 3-25)

Clearly, this cited portion of Hoffman has nothing to do with *calculating a payment that is based on a modification of a parameter from a first value to a second value, and then providing an offer to a customer associated with a credit account, wherein the offer is to provide the payment to the customer if the customer agrees to the modification.* Accordingly, Hoffman does not support the Examiner’s position that such operation was known, and since Hoffman is the only evidence of record offered in support of such a finding, no *prima facie* case of obviousness has been established.

Furthermore, there is no evidence to support a motivation to combine Wilcox and Hoffman. The Examiner asserts that the motivation is: “*because such a modification would allow Wilcox to provide a customer with special services if the customer agrees to and complies with the credit regulations.*” [Office Action, page 5]. But there is no indication of any evidence of record that supports the alleged motivation. Furthermore, there is also no evidence of why one of ordinary skill in the art would have looked to the system for promoting account activity of Hoffman to modify the prequalifying process disclosed by Wilcox, as these systems do not appear to be analogous, and no evidence is given that they are. But even if there were some evidence, nowhere is it suggested to modify Wilcox to allow for *providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter.*

In view of the above remarks, the Section 103(a) rejection of claims **49, 61 and 62** cannot stand. In addition, the obviousness rejections of claims **50-60** must be withdrawn, as these claims either directly or indirectly depend on claim **49**.

Independent claims **70, 73 and 74** were rejected:

“... for the (sic.) similar rationale as given above for claims 61 and 62.” (Page 8 of the Office Action)

But the Wilcox and Hoffman references are deficient as explained above, and thus do not teach or suggest the method and apparatus for modifying at least one term of the credit account as recited by these claims. In addition, the Examiner completely ignored the limitation recited in each of claims **70, 73 and 74** of *determining that a customer associated with a credit account is dissatisfied with the credit account.* Nothing in Wilcox or Hoffman even remotely hints at customer dissatisfaction associated with a credit account. Moreover, the Examiner

has not even attempted to explain how any particular language in the cited portions or otherwise in Wilcox or Hoffman might suggest the claimed subject matter.

Accordingly, the Section 103 rejections of claims **70, 73 and 74** cannot stand. In addition, the obviousness rejections of claims **75-79** must be withdrawn, as these claims either directly or indirectly depend on claim **70**.

Claim **80** stands rejected for the following reason:

“Claim 80. This independent claim is rejected for similar rationale as above for claim 1.” (Page 10 of the Office Action)

We assume that the Examiner meant to indicate “claim **49**”, as claim 1 was previously canceled without prejudice. If this assumption is correct, the Examiner has erroneously relied on her rejections of claim **49**, as claim **80** recites *calculating... a payment, and providing an offer to the customer, in which the offer comprises an offer to provide the payment to the customer if the customer agrees to a modification...*”. As explained above, such operation is not taught or suggested by the cited art. In addition, the explicit features of *receiving an indication that the customer agrees to the modification and providing the payment to the customer after receiving the indication* found in claim **80** have been ignored. Nothing in the cited art suggests such operation. Thus, the Examiner has failed to establish, with substantial evidence, that all of the claimed subject matter was known.

Consequently, the obviousness rejection of Claim **80** cannot stand.

E. Conclusion

Applicants respectfully request review and reversal of the objection to claim **73**, the Section 112 rejections of claims **49, 61, 62, 73, 74 and 80**, and the Section 103(a) rejections of all of the pending Claims **49-62, 70 and 73-80**.

Respectfully submitted,

October 30, 2006
Date

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